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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,366	11/21/2003	Akira Unosawa	04110/100H147-US1	3591
7278	7590	05/09/2005	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			BLAU, STEPHEN LUTHER	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/719,366

**Applicant(s)**

UNOSAWA, AKIRA

**Examiner**

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 is/are allowed.
- 6) ☒ Claim(s) 7,9,11 and 14 is/are rejected.
- 7) ☒ Claim(s) 8,10,12,13,15 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/21/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 recites the limitation "the core rod" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Santorelli in view of Suganua.

Santorelli discloses a shaft filled with a resilient material (Col. 2, Lns. 10-20) having a feature in which a rapid application of force causes a high repelling force to be

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acted on it to be hardly deformed and in turn a gradual application of force causes a shaft to be easily deformed (Abstract), and a resilient material filling from 8 inches to half the length of a shaft (Col. 2, Lns. 1-15).

Santorelli lacks a resilient material being filled from 30-40 cm (11.8-15.7 inches) from near an end part. Suganuma discloses clubs being a length of 35 to 43 inches (Table 1) wherein half the length would be 17 to 21.5 inches. In view of the patent of Suganua it would have been obvious to modify the shaft of Santorelli to have a resilient material being filled from 30-40 cm from near an end part of a shaft in order to provide resilient material for a clubs having a length of 35 to 43 inches.

5. Claims 7, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 6-182007 in view of Santorelli, Suganuma and Billings.

JP 6-182007 discloses a golf club shaft having an entire inner region (paragraph 0008, translated) filled with a resilient material in a form of foam, preferably inactive foam (polyethylene or styrene) (DERWENT Abstract), the resilient material is adhered and fixed to the inside of the shaft through compressing the foam prior to inserted it into the shaft such that the foam expanding causes the foam to be adhered and fixed inside the shaft (translated), and a second embodiment of placing foam in only a portion of the shaft (5cm in length) at the joint of the shaft and the head (paragraph 11, translated) in order to prevent a numbing feeling felt by a player (DERWENT, Abstract).

JP 6-182007 lacks an upper end of a resilient material being adhered to and fixed to a shaft, a resilient material having a feature in which a rapid application of force

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causes a high repelling force to be acted on it to be hardly deformed and in turn a gradual application of force causes a shaft to be easily deformed, and a range of filling the resilient material from 30 cm to 40 cm from the neck end of a shaft. Clearly an artisan skilled in the art of placing compressed foam in a shaft along all or part of the entire length to dampen vibrations would have compressed fitted a suitable amount of the foam in which the entire length of the foam is included.

Santorelli discloses a shaft filled with an active resilient material (Col. 2, Lns. 10-20) having a feature in which a rapid application of force causes a high repelling force to be acted on it to be hardly deformed and in turn a gradual application of force causes a shaft to be easily deformed (Abstract) and a resilient material filling from 8 inches to half the length of a shaft (Col. 2, Lns. 1-15) in order to allow a stronger golfer to use a more flexible shaft and still maintain accuracy and distance (Col. 1, Lns. 35-36). Billings discloses placing a foam within a shaft or a portion of a shaft such as a tip end to alter the sound characteristics of a putter (Col. 5, Lns. 22-34). Sukanuma discloses clubs being a length of 35 to 43 inches (Table 1) wherein half the length would be 17 to 21.5 inches. In view of the patent of Santorelli it would have been obvious to modify the shaft of JP 6-182007 to have an active foam having a feature in which a rapid application of force causes a high repelling force to be acted on it to be hardly deformed and in turn a gradual application of force causes a shaft to be easily deformed in order to have a shaft which both dampens vibrations and allows a stronger golfer to use a more flexible shaft and still maintain accuracy and distance.

In view of the patent of Santorelli, Suganuma and Billings it would have been obvious to modify the shaft of JP 6-182007 to have range of filling a resilient material from 30 cm to 40 cm from the neck end of a shaft in order to save money by not placing the resilient material throughout the entire shaft.

It would have been obvious to modify the club of JP 6-182007 to have an upper end of a resilient material being adhered to and fixed to a shaft as well as the entire location of the foam in order to ensure the foam is fixed inside a shaft.

***Allowable Subject Matter***

6. Claims 1-6 are allowed. None of the prior art discloses or renders as obvious resilient material having a feature in which a rapid application of forces causes a high repelling force and a gradual application of force causes a shaft to easily deform and a core rod inserted into the resilient material in addition to other elements of structure.

7. Claims 8, 10, 12-13, and 15-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the prior art discloses or renders as obvious resilient material having a feature in which a rapid application of forces causes a high repelling force and a gradual application of force causes a shaft to easily deform and a core rod inserted into the resilient material in addition to other elements of structure.

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*Conclusion*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 6 May 2005

  
**STEPHEN BLAU**  
**PRIMARY EXAMINER**